

37. (Previously Presented) A stack of hangers for framing material, comprising:

a plurality of hangers, each having a web extending between a pair of legs, which legs extend outwardly from the web in a direction substantially perpendicular to the web, and a barbed member extending out from each leg; and

one or more shearable tabs extending between, and attaching, adjacent ones of the plurality of hangers, wherein the tabs are coplanar with the web.

38. (Previously Presented) The stack of hangers of claim 37, wherein each leg has a shoulder surface spaced apart from the web, and the barbed member extends out from each respective leg adjacent the shoulder surface.

39. (Previously Presented) The stack of hangers of claim 37, wherein the tabs each have a feature that facilitates shearing of the tab.

Remarks:

3. Claims 26-31 and 37-39 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,339,983 (hereinafter referred to as the “ ‘983 Patent”). Applicant respectfully submits that the subject matter recited within claims 26-31 is not anticipated by the disclosure of the ‘983 patent.

The ‘983 Patent:

The ‘983 patent discloses a clamping device for plate-like members such as corrugated boards. (Col. 3, lines 28-29). The clamping device includes a base portion 9 and a pair of pivotal pieces 10a and 10b connected to the base portion 9 by thin hinge portions 11a and 11b. Curved claws 15a and 15b extend out from the pivot pieces 10a and 10b. The clamping device is “formed by one-piece molding, for example, of *flexible synthetic resin material* such as polypropylene” (Col. 3, lines 31-32; emphasis added). Indeed, a flexible material is a requirement of the one-piece molded clamping device in that the pivot pieces 10a, 10b must be pivotable relative to the base 9 for the device to be clamped and unclamped. The flexible material of the device is further illustrated by the

disclosure that: "if the plate-like members are composed of material other than corrugated boards, into which the piercing pieces 15a and 15b cannot be readily caused to penetrate, such plate-like members should preferably be formed with suitable openings which permit reception of the piercing pieces 15a and 15b." (Col. 4, lines 35-41)

In one embodiment, a plurality of clamping devices are connected to one another by "wire-like connecting members 23 suitably fixed to the under surfaces of the base portions 9 of the clamping devices CC with each of the connecting members 23 being formed with an engagement portion or hook 24 at one end of the group CD for connection with another similar group of clamping devices." (Col. 6, lines 9-15) There is no disclosure within the '983 Patent that the wire-like connecting members 23 are shearable members. On the contrary, the '983 member discloses a hook 24 at one end of the wire 23 for mechanical engagement of an adjacent clamping device.

The Present Stack of Hangers:

Claim 26 recites a stack of hangers for framing material that includes a plurality of hangers and one or more shearable tabs extending between, and attaching, adjacent ones of the plurality of hangers. The hangers of claim 26 are recited as an element of the stack of hangers. The '983 patent does not disclose any hangers at all. The '983 patent discloses flexible clamping devices. The classic test for anticipation, under 35 U.S.C. §102, requires that every limitation in a claim must be present in a prior art reference for that prior art reference to "anticipate" the claimed invention. The '983 patent does not disclose hangers at all. Consequently, it cannot anticipate the device of claim 26.

Furthermore, the Examiner states that "if the prior art structure is capable of performing the intended use, then it meets the claim". It is very clear from the description of the clamping device in the '983 Patent, that the device cannot perform the intended use. As stated above, the clamping device of the '983 patent is formed of a flexible material unsuitable for use as a hanger. This fact is particularly well illustrated by the above-cited disclosure that: "if the plate-like members are composed of material other than corrugated boards, into which the piercing pieces 15a and 15b cannot be readily caused to penetrate, such plate-like members should preferably be formed with suitable openings which permit reception of the piercing pieces 15a and 15b." (Col. 4,

lines 35-41; emphasis added). A device that can only penetrate corrugated boards is not suitable as a hanger for framing materials.

In addition to the fact that the '983 Patent does not disclose a hanger, the device that is disclosed in the '983 Patent also does not include shearable tabs. As stated above, the '983 Patent discloses a connecting member 23 with a hook 24 for connection with an adjacent clamping device. The hook 24 appears to be a mechanical means of attachment between adjacent clamping members. There is no disclosure within the '983 Patent that the wire-like connecting members 23 are shearable tabs.

For at least these reasons, applicant respectfully requests the rejection of claims 26-31 and 37-39 be withdrawn.

Regarding dependent claim 27, in addition to not disclosing a hanger (see remarks above) the '983 also does not disclose a hanger or other structure wherein each leg has a shoulder surface spaced apart from the web, and the barbed member extends out from each respective leg adjacent the shoulder surface. The rejection states that the clamping device of the '983 patent includes shoulders 13a and 13b. The '983 patent discloses that reference numerals 13a and 13b refer to recesses for receiving pivotal pieces 10a and 10b. Consequently, the clamping device of the '983 patent does not include legs, each having a shoulder surface and a barbed member extending out from the leg adjacent the shoulder surface. Because every limitation in the claim is not present in the '983 patent, claim 27 cannot be anticipated by the '983 patent. For at least these reasons, applicant respectfully requests the rejection of claim 27 be withdrawn.

Regarding dependent claim 29, in addition to not disclosing a hanger (see remarks above) the '983 Patent also does not disclose a stack of hangers wherein the shearable tabs extending between, and attaching, adjacent hangers each have a feature that facilitates shearing of the tab. Because every limitation in the claim is not present in the '983 patent, claim 29 cannot be anticipated by the '983 patent. For at least these reasons, applicant respectfully requests the rejection of claim 29 be withdrawn.

Regarding claims 37-39, independent claim 37 recites a stack of hangers for framing material that includes a plurality of hangers and one or more shearable tabs extending between, and attaching, adjacent ones of the plurality of hangers, wherein the tabs are coplanar with the web. Applicant respectfully directs the Examiner to the

remarks above regarding the absence of any hanger disclosure within the '983 Patent and the characteristics of the clamping device that make it incapable of performing as a framing material hanger.

In addition to the above-identified distinguishing characteristics, the stack of hangers recited in claim 37 is further distinguished from the cited prior art reference by the tabs extending between, and attaching, adjacent hangers, ***which tabs are coplanar with the webs of the adjacent hangers***. The coplanar orientation of the hangers and tabs within the stack make it possible to stamp the stack out of material in sheet-form. As a result, the stacks can be easily manufactured in a cost-effective manner. The disclosure within the '983 Patent of wire-like connecting members suitably fixed to the under surfaces of the base portions of the clamping devices, does not anticipate the recited structure.

For at least these reasons, applicant respectfully requests the rejection of claims 37-39 be withdrawn.

Dependent claim 38 further defines the hangers within the stack, reciting that each leg has a shoulder surface spaced apart from the web, and the barbed member extends out from each respective leg adjacent the shoulder surface. As stated above under the remarks to claim 27, the rejection states that the clamping device of the '983 patent includes shoulders 13a and 13b. The '983 patent discloses that reference numerals 13a and 13b refer to recesses for receiving pivotal pieces 10a and 10b. Consequently, the clamping device of the '983 patent does not include legs, each having a shoulder surface and a barbed member extending out from the leg adjacent the shoulder surface. Because every limitation in the claim is not present in the '983 patent, claim 38 cannot be anticipated by the '983 patent. For at least these reasons, applicant respectfully requests the rejection of claim 38 be withdrawn.

Regarding dependent claim 39, in addition to not disclosing a hanger (see remarks above) the '983 Patent also does not disclose a stack of hangers wherein the tabs extending between, and attaching, adjacent hangers each have a feature that facilitates shearing of the tab. Because every limitation in the claim is not present in the '983 patent, claim 39 cannot be anticipated by the '983 patent. For at least these reasons, applicant respectfully requests the rejection of claim 39 be withdrawn.

4. Claims 26-31 and 37-39 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,728,237 (hereinafter the “ ‘237 Patent”) in view of the ‘983 Patent.

In the Office Action of August 5, 2005, the Examiner indicates that claims 26-31 and 37-39 are rejected as being obvious over “Samson et al. (USPN 4,728,237) in view of...”. The ‘237 Patent is not issued to Samson. Applicant understands the rejection to be based on the ‘237 Patent issued to Lorincz et al. If the applicant’s understanding is incorrect, clarification is respectfully requested.

When an application is submitted to the Patent and Trademark Office, statute¹ and case law² dictates that the burden of proof is on the PTO to establish a prima facie case of obviousness.³ Once the prima facie case has been established, then the burden of going forward with the evidence to rebut the prima facie case shifts to the applicant.⁴ Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.⁵ In this instance, a prima facie case would necessarily have to first establish that the combined teachings of the ‘237 Patent and the ‘983 Patent render the claimed subject matter obvious⁶, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.⁷ The suggestion or motivation to combine the references must not be a hindsight

¹ 35 U.S.C. 132.

² See In re Warner, 154 USPQ 173, 178 (C.C.P.A. 1967); In re Oetiker, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

³ In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984).

⁴ In re Carleton, 202 U.S.P.Q. 165,168 (CCPA 1979).

⁵ Ashland Oil v. Delta Resins and Refractories, Inc., 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): “In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ‘[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’ The patent applicant may then attack the Examiner’s prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.”.

⁶ In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979) citing In re Bozek, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

⁷ ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984), “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so.”

reconstruction of isolated disclosures within the prior art.⁸ Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.⁹

The '237 Patent discloses single hangers. Nothing in the '237 Patent teaches or suggests a stack of hangers.

As stated above, the '983 Patent discloses a connecting member 23 with a hook 24 for connection with an adjacent clamping device, attached to an under surface of the clamping member. The hook 24 appears to be a mechanical means of attachment between adjacent clamping members. There is no disclosure within the '983 Patent that the wire-like connecting members 23 are shearable tabs as is recited in independent claims 26 and 37.

The combined teachings of the '237 Patent and the '983 Patent, therefore, do not arrive at the stack of hangers recited within independent claims 26 and 37. For that reason alone, the stack of hangers recited within claims 26 and 37 are not obvious in view of the combined teachings of the '237 Patent and the '983 Patent.

In addition, however, independent claim 37 also recites that the one or more shearable tabs extending between, and attaching, adjacent ones of the plurality of hangers are coplanar with the web. Neither reference discloses shearable tabs coplanar with the web. The coplanar orientation of the hangers and tabs within the stack make it possible to stamp the stack out of material in sheet-form. As a result, the stacks are can be easily manufactured in a cost-effective manner. In a mass-produced, single use product like the claimed stack of hangers, it is imperative that the product be manufacturable in a cost effective manner.

Beyond the fact that the cited references do not disclose the claimed stack of hangers, there is also no suggestion or motivation within either reference to combine the two references to arrive at the claimed invention. The Examiner points to Col. 6, lines 5-21 as providing the suggestion to use connecting members to connect hangers. Applicant respectfully submits that the cited passage does not cure the deficiencies of the cited

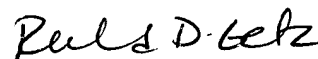
⁸ In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992), “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”, quoting In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

⁹ In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

references. To the extent that the '983 Patent discloses a mechanism for joining clamping members, it is limited to the structure disclosed within the '983 patent; i.e., wire-like connecting members with hooks or other mechanical attachment features. There is no suggestion to modify either reference to arrive at the claimed invention. Consequently, the stack of hangers recited in claims 26-31 and 37-39 are not obvious in view of the combination of references cited by the Examiner, and applicant respectfully requests the rejection be withdrawn.

As applicant has traversed the rejection made by the Examiner, it is respectfully requested that the stated rejection be withdrawn, claims 26-31 and 37-39 be allowed, and the present application be passed onto issuance. No fee is believed due at present. In the event a fee is due, however, please charge our Deposit Account No. 50-3381.

Respectfully submitted,



Richard D. Getz
Registration No. 36,147
Attorney for Applicant

O'Shea, Getz & Kosakowski, P.C.
Suite 912
1500 Main Street
Springfield, MA 01115
413-731-3100